



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,530	12/05/2001	Naoto Akimoto	1232-4792	1342

27123 7590 05/19/2005  
MORGAN & FINNEGAN, L.L.P.  
3 WORLD FINANCIAL CENTER  
NEW YORK, NY 10281-2101

EXAMINER
----------

MENBERU, BENIYAM

ART UNIT	PAPER NUMBER
----------	--------------

2626

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/006,530	Applicant(s) AKIMOTO ET AL.	
	Examiner Beniyam Menberu	Art Unit 2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2001.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some    \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/5/2001</u> . | 6) <input checked="" type="checkbox"/> Other: <u>Detailed Action</u>                    |

## **DETAILED ACTION**

### ***Specification***

1. The disclosure is objected to because of the following informalities:

On page 18, line 15, "hybrid circuit 96" does not match with the reference 98 labeled "Hybrid Circuit" in Figure 9.

On page 22, line 22-23, after step S1316, it should proceed to step S1320 if it results in "Yes" in step S1316.

Appropriate correction is required.

### ***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 92b, 92c in Figure 9. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the

examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "98" has been used to designate both Hybrid Circuit and Modulation/Demodulation Unit in Figure 9. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to because in Figure 12, step S1202 "Initialize Memory 18" should be "Initialize Memory 918". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the

several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 2, 8, 16, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6356356 to Miller, Jr. et al.

Regarding claims 1, 16, and 18, Miller, Jr. et al disclose a communication apparatus/method/program (Figure 1, reference 18, 12) comprising:  
reception means for receiving data (Figure 1, reference 18; column 5, lines 38-41);

Art Unit: 2626

conversion means for converting the received data into electronic mail (Figure 2, reference 36; column 4, lines 56-65); and  
transmission means for transmitting the electronic mail converted by said conversion means to be forwarded to a plurality of destinations (column 5, lines 54-67; column 6, lines 1-8).

Regarding claim 2, Miller, Jr. et al teach all the limitations of claim 1. Further Miller, Jr. et al disclose the communication apparatus according to claim 1, wherein said conversion means attaches an image received by said reception means to the electronic mail (column 5, lines 63-67).

Regarding claim 8, Miller, Jr. et al teach all the limitations of claim 1. Further Miller, Jr. et al disclose the communication apparatus according to claim 1, wherein said reception means receives said image based on a facsimile procedure (column 5, lines 35-41).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2626

*km*

8. Claims 3, 4, 5, 10, 12, 13, 14, 15, ~~16~~, 17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6356356 to Miller, Jr. et al in view of U.S. Patent No. 6658456 to Shimoosawa.

Regarding claim 3, Miller, Jr. et al teach all the limitations of claim 1. However Miller, Jr. et al does not disclose the communication apparatus according to claim 1 further comprising:

registration means for registering the plurality of destinations for said transmission means to transmit said electronic mail.

Shimoosawa disclose the communication apparatus further comprising: registration means for registering the plurality of destinations for said transmission means to transmit said electronic mail (Figure 4, reference 52; column 4, lines 66-67; column 5, lines 1-11).

Miller, Jr. et al and Shimoosawa are combinable because they are in the similar problem area of email forwarding of data.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the registration system of Shimoosawa with the system of Miller, Jr. et al to implement registration of email address for forwarding data.

The motivation to combine the reference is clear because by registering email address will make forwarding of received data quicker.

Regarding claim 4, Miller, Jr. et al in view of Shimoosawa teach all the limitations of claim 1. Further Miller, Jr. et al in view of Shimoosawa discloses the communication apparatus according to claim 3, wherein said conversion means

attaches the image received by said reception means to the electronic mail (Miller, Jr. et al: column 5, lines 63-67), and said registration means has a method of attaching said image registered for each destination (Shimoosawa: Figure 4, reference 53; column 5, lines 13-29).

Regarding claim 5, Miller, Jr. et al in view of Shimoosawa teach all the limitations of claim 4. Further Miller, Jr. et al in view of Shimoosawa discloses the communication apparatus according to claim 4, wherein said method of attaching also includes information on whether or not to attach said image to the electronic mail (column 5, lines 13-20).

Regarding claims 10, 17, and 19, Miller, Jr. et al disclose a communication apparatus/method/program (Figure 1, reference 18, 12) comprising:  
reception means for receiving data (Figure 1, reference 18; column 5, lines 38-41);  
management means for managing a forwarding destination (Figure 2, reference 34; column 4, lines 43-56);  
transmission means for transmitting the data received by said reception means as electronic mail (Figure 2, reference 38; column 4, lines 61-65). However Miller, Jr. et al does not disclose management means for managing setting on forwarding of received data for each mail address of the data received by said reception means; and transmitting the data as electronic mail based on information managed by said management means.



Shimoosawa disclose management means for managing setting on forwarding of received data for each mail address of the data received by said reception means (Figure 4, reference 53; column 5, lines 13-29); and transmitting the data as electronic mail based on information managed by said management means (Figure 3, reference 44; column 6, lines 25-37).

Miller, Jr. et al and Shimoosawa are combinable because they are in the similar problem area of email forwarding of data.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the management setting of Shimoosawa with the system of Miller, Jr. et al to implement management of data forwarding.

The motivation to combine the reference is clear because managing the setting can help forward received data quicker and efficient.

Regarding claim 12, Miller, Jr. et al in view of Shimoosawa teach all the limitations of claim 10. Further Shimoosawa discloses the communication apparatus according to claim 10, wherein said management means manages whether to transmit only the text (column 8, lines 50-61), transmit only the attachment file (column 10, lines 55-67) or transmit both the text and the attachment file of said received data (column 9, lines 62-67; column 10, lines 1-16).

Regarding claim 13, Miller, Jr. et al in view of Shimoosawa teach all the limitations of claim 10. Further Miller, Jr. et al disclose the communication apparatus according to claim 10, wherein said management means is capable of managing a plurality of said forwarding destinations for each address (column 5, lines 53-67).

Regarding claim 14, Miller, Jr. et al in view of Shimoosawa teach all the limitations of claim 10. Further Shimoosawa disclose the communication apparatus according to claim 10, wherein said management means manages whether or not the forwarding destination is a mobile terminal (Shimoosawa discloses that mobile PDA can be used as recipient of email data (column 1, lines 24-29; column 8, lines 48-55; column 9, lines 1-13)).

Regarding claim 15, Miller, Jr. et al in view of Shimoosawa teach all the limitations of claim 14. Further Shimoosawa disclose the communication apparatus according to claim 14, wherein said management means manages the setting in the case of forwarding to the mobile terminal (Shimoosawa teaches that when transferring data to mobiles like PDA, the attachments can be excluded from the data sent to prevent the PDAs from becoming memory full (column 8, lines 48-67)).

9. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6356356 to Miller, Jr. et al in view of U.S. Patent No. 6658456 to Shimoosawa further in view of U.S. Patent No. 6721783 to Blossman et al.

Regarding claim 6, Miller, Jr. et al in view of Shimoosawa teach all the limitations of claim 4. However Miller, Jr. et al in view of Shimoosawa does not disclose the communication apparatus according to claim 4, wherein said method of attaching includes information on whether to attach all or a part of said received image.

Blossman et al disclose the communication apparatus, wherein said method of attaching includes information on whether to attach all or a part of said received image (Blossman et al disclose method of sending bank customers images of bank related

Art Unit: 2626

documents through email based on customer preference on which documents to be sent (column 16, lines 1-5, lines 23-33, lines 45-54).).

Miller, Jr. et al, Shimoosawa, and Blossman et al are combinable because they are in the similar problem area of email forwarding of data.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the selective email transmission system of Blossman et al with the system of Miller, Jr. et al in view of Shimoosawa to implement destination specific transmission of image data.

The motivation to combine the reference is clear because the teaching of Blossman et al can implement a destination specific transmission of important documents based on preference of users (column 4, lines 38-41).

10. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6356356 to Miller, Jr. et al in view of U.S. Patent No. 6658456 to Shimoosawa further in view of U.S. Patent No. 6266160 to Saito et al.

Regarding claim 7, Miller, Jr. et al in view of Shimoosawa teach all the limitations of claim 4. However Miller, Jr. et al in view of Shimoosawa does not disclose the communication apparatus according to claim 4, wherein said method of attaching includes information on an encoding system of said attached image.

Saito et al disclose the communication apparatus according to claim 4, wherein said method of attaching includes information on an encoding system of said attached image (Figure 3, "Supported Data Format"; column 3, lines 17-24, lines 65-67; column 4, lines 1-6).

Miller, Jr. et al, Shimoosawa, and Saito et al are combinable because they are in the similar problem area of email forwarding of received data.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the encoding specification of Saito et al with the system of Miller, Jr. et al in view of Shimoosawa to implement destination specific encoding of image data.

The motivation to combine the reference is clear because Saito et al teaches that the data format depends on capability of receiving side thus there is a need to include information on encoding(column 4, lines 1-6).

11. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6356356 to Miller, Jr. et al in view of U.S. Patent No. 6883016 to Fujii et al.

Regarding claim 9, Miller, Jr. et al teaches all the limitations of claim 8. However Miller, Jr. et al does not disclose the communication apparatus according to claim 8, wherein said facsimile procedure is based on the ITU-T T. 37 recommendation.

Fujii et al disclose facsimile procedure based on the ITU-T T. 37 recommendation (column 1, lines 15-24).

Miller, Jr. et al and Fujii et al are combinable because they are in the similar problem area of email transmission.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the ITU-T T.37 standards of Fujii et al with the system of Miller, Jr. et al.

The motivation to combine the reference is clear because Fujii et al teaches that image transmission through email is done using ITU-T T.37 standard (column 1, lines 20-23).

12. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6356356 to Miller, Jr. et al in view of U.S. Patent No. 6658456 to Shimoosawa further in view of U.S. Patent No. 6883016 to Fujii et al.

Regarding claim 11, Miller, Jr. et al in view of Shimoosawa teaches all the limitations of claim 10. However Miller, Jr. et al in view of Shimoosawa does not disclose the communication apparatus according to claim 10, wherein said facsimile procedure is based on the ITU-T T. 37 recommendation.

Fujii et al disclose facsimile procedure based on the ITU-T T. 37 recommendation (column 1, lines 15-24).

Miller, Jr. et al, Shimoosawa, and Fujii et al are combinable because they are in the similar problem area of email transmission.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the ITU-T T.37 standards of Fujii et al with the system of Miller, Jr. et al.

The motivation to combine the reference is clear because Fujii et al teaches that image transmission through email is done using ITU-T T.37 standard (column 1, lines 20-23).

***Other Prior Art Cited***

1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6097797 to Oseto disclose network facsimile device.

U.S. Patent Application Publication No. US 2002/0016818 A1 to Kirani et al disclose email attachment delivery methods.

U.S. Patent No. 6671063 to Iida disclose network facsimile apparatus.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beniyam Menberu whose telephone number is (571) 272-7465. The examiner can normally be reached on 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (571) 272-7471. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is (571) 272-2600. The group receptionist number for TC 2600 is (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published

Art Unit: 2626

applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov/>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**Patent Examiner**

Beniyam Menberu

BM

05/14/2005

KAWilliams